

REMARKS

This responds to the Office Action mailed on February 2, 2007.

Claims 1, 4, 7, 17, 24, 32, 38, 44 and 47 are amended, claims 9, 19, 26, 34, 40 and 49 are canceled without prejudice or disclaimer, and no claims are added; as a result, claims 1-8, 10-18, 20- 25, 27-33, 35-39, 41-48 and 50-52 remain pending in this application. Support for the amendments may be found throughout the specification, and in particular on pages 12-13 of the specification.

Claim Objections

Claim 26 was objected to as being dependent upon itself. Claim 26 has been canceled in this response.

Double Patenting Rejection

Claims 1-51 were rejected under the judicially created doctrine of double patenting over claims 1-28 of Loose et al. (U.S. 6,517,433) in view of Poole (U.S. 6,375,570). Applicant does not admit that claims 1-51 are obvious in view of Loose and Poole. Applicant will consider filing a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(b)(iv) or other response when the status of the claims with respect to the rejections based on 35 U.S.C. §102 are resolved.

§102 Rejection of the Claims

Claims 1-52 were rejected under 35 U.S.C. § 102(e) for anticipation by Loose et al. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Applicant respectfully submits that a

prima facie case of anticipation does not exist because the claims contain elements not found in Loose.

Each of the independent claims 1, 4, 7, 17, 24, 32, 38, 44 and 47 recite elements directed to overlaying a supplemental image over a game element image on a display device. For example, claim 1 recites “overlaying pixel values of the at least one symbol element with pixel values of the supplemental graphical element”. Claims 4, 17, 24, 32 and 38 recite similar language. Loose does not disclose overlaying pixel values of a symbol element or game element with values with pixel values of a supplemental graphical element or video image. In Loose, symbols are displayed on a mechanical rotatable reel (see Loose at Abstract, FIG. 1, and column 2, lines 19-25). The symbols on the mechanical reels of Loose are not described as having pixel values associated with them. Thus Loose does not disclose overlaying pixel values for supplemental graphical images with pixel values of a symbol. As a result, Loose does not disclose each and every element of claims 1, 4, 17, 24, 32 and 38.

Claim 7 recites that “multiple game element images” are “displayed within multiple game element areas of a display device” and that a “set of video images appears as an overlay over one or more of the multiple game element images” on the display device. Claims 44 and 47 recite similar language. Loose does not disclose displaying both symbols and supplemental images on a single display device. As noted above, the symbols in Loose are disclosed as appearing on mechanical reels. A separate display device is mounted apart from the reels, either above or below the reels that generates displays images such that the image appears over the reels (see Loose at column 2, lines 39-60). Thus the symbols are not provided on the same display device that displays the images. As a result, Loose does not disclose each and every element of claims 7, 44 and 47.

In view of the arguments provided above, Loose does not disclose each and every element of claims 1, 4, 7, 17, 24, 32, 38, 44 and 47. Thus Loose does not anticipate claims 1, 4, 7, 17, 24, 32, 38, 44 and 47. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 4, 7, 17, 24, 32, 38, 44 and 47.

Claims 2-3, 5-6, 8, 10-16, 18, 20- 23, 25, 27-31, 33, 35-37, 39, 41-43, 45-46, 48 and 50-52 are dependent claims that depend either directly or indirectly from one of base claims 1, 4, 7, 17, 24, 32, 38, 44 or 47. These dependent claims inherit the elements of the respective base

claims and are therefore allowable over Poole for at least the reasons discussed above regarding their base claims, and in addition for the patentable elements provided in the dependent claims. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 2-3, 5-6, 8, 10-16, 18, 20- 23, 25, 27-31, 33, 35-37, 39, 41-43, 45-46, 48 and 50-52.

Claims 1-52 were rejected under 35 U.S.C. § 102(b) for anticipation by Poole. Applicant respectfully submits that a *prima facie* case of anticipation does not exist because the claims contain elements not found in Poole.

Each of the independent claims 1, 4, 7, 17, 24, 32, 38, 44 and 47 recite elements directed to overlaying a supplemental image over a game element image on a display device where the game element image remains partially visible either through or around the overlaid supplemental image. For example, claim 1 recites “at least one symbol element remains at least partially visible while the supplemental graphical element is displayed.” Claims 4, 7 ,17, 24, 32, 38, 44 and 47 recite similar language. Poole does not disclose overlaying a supplemental image over a game image in the manner recited in Applicant’s claims. Rather than having game elements remain at least partially visible as recited in Applicant’s claims, Poole discloses replacing one or more symbol images with another image. For example, at column 2, lines 40-42, Poole states that the system “replaces certain of the reels to perform an exhibition.” Similarly, claim 1 of Poole states that the exhibition “replaces at least one of said video reels.” When the exhibition is over, the reels replace the exhibition display (see column 7, lines 43-46). Thus rather than keeping symbols or game elements partially displayed, Poole replaces the symbols. As a result, Poole does not disclose each and every element of claims 1, 4, 7, 17, 24, 32, 38, 44 and 47. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 4, 7, 17, 24, 32, 38, 44 and 47.

Claims 2-3, 5-6, 8, 10-16, 18, 20- 23, 25, 27-31, 33, 35-37, 39, 41-43, 45-46, 48 and 50-52 are dependent claims that depend either directly or indirectly from one of base claims 1, 4, 7,17, 24, 32, 38, 44 or 47. These dependent claims inherit the elements of the respective base claims and are therefore allowable over Poole for at least the reasons discussed above regarding their base claims, and in addition for the patentable elements provided in the dependent claims. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 2-3, 5-6, 8, 10-16, 18, 20- 23, 25, 27-31, 33, 35-37, 39, 41-43, 45-46, 48 and 50-52.

RESERVATION OF RIGHTS

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 10/659,581

Filing Date: September 9, 2003

Title: ELECTRONIC GAME AND SYSTEM HAVING OVERLAYERED VIDEO IMAGES

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Dkt: 1842.002US1

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

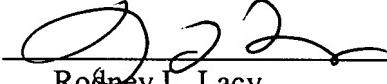
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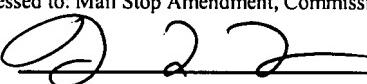
Date May 2, 2007

By


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 3rd day of May 2007.

Rodney L. Lacy
Name


Signature